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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,991

Applicant(s)

HILBERT ET AL.

Examiner

LUU PHAM

Art Unit

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 85-90 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the Amendment filed on 10/29/2008.
2. In the instant Amendment, Claims 85-90 were previously withdrawn; Claims 1, 29, and 57 have been amended; Claims 1, 29, and 57 are independent claims. Claims 1-84 have been examined and are pending. **This Action is made FINAL.**

Response to Arguments

3. The rejections of claims 29-56 under 35 U.S.C. § 101 are withdrawn as the claims have been amended.
4. The rejections of claims 1-28 and 57-84 under 35 U.S.C. § 112, second paragraph, are withdrawn as the claims have been amended.
5. Applicants' arguments with respect to claims 1, 29, and 57 regarding the limitation *"accessing credentials that enable the proxy server to access the file at the file sources"* have been considered but are moot in view of the new ground(s) of rejection.
6. Applicants' arguments with respect to claims 1, 29, and 57 regarding limitation listed below, have been fully considered but they are not persuasive.

Applicants' arguments:

- a. *"Gong fails to disclose updating the original file located at the file source based on the modifications to the proxy representation received at the proxy server, as defined in amended Claim 1."*

The Examiner disagrees for the following reasons:

- a. Gong disclose updating the file located at the file source based on the modifications to the proxy representation received at the proxy server by using the location information (*pars. 0009, 0012, 0033, and 0037-0038; Fig. 2; all users having rights to access the attachments will receive e-mail notifications for any version or content update of a file; IMS will manage and log all check-in, checkout and modification activities related to the attachment, and maintain one updated master copy*) (emphasis added).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability

of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. **Claims 1-16, 19-44, 47-72, and 75-84 are rejected under 35 U.S.C. 102(e)** as being unpatentable over Gong, U.S. Patent Publication No. 2004/0064733, filed on June 26, 2003, in view of DeBry, U.S. Patent No. 6,385,728, issued on May 07, 2002.

- **Regarding claim 1**, Gong discloses a method for sharing files with remote users (*par. 0009; Fig. 2*), the method comprising:

Accepting, at a proxy server, a request from a file sharer to share a file with a remote user, the file located at a file source (*pars. 0009, 0020, 0029, and 0031-0034; Fig. 2; user sends emails with attachments through email client interface; Project/Information Management Server (IMS) receives the attachment files or documents along with identification information (descriptor and locator)*);

accessing credentials, the credentials configured to enable [[the proxy server]] to access the file at the file sources (*pars. 0009, 0030, and 0033; users can access the Client Project Information Management Web Interface to manage attachment information; login authentication is needed*)

generating a proxy representation for the file on the proxy server, the proxy representation associated with the remote user and storing location information of the file on the proxy server (*pars. 0009, 0031-0034, and 0036-0038; Fig. 2; a unique attachment descriptor and locator will be generated to identify the save attachment; a version controlled copy of the original attachment from the IMS; the IMS will pass the version*

controlled file(s) back to Adapter Engine, then to recipient local machine; the recipient can modify the file(s) in his/her local machine and check in the modified version through email).

receiving one or more modifications to the proxy representation (pars. 0009, 0012, 0033, and 0037-0038; Fig. 2; the recipient can modify the file(s) in his/her local machine and check in the modified version through email or through Client Information Management Web Interface); and

updating the file located at the file source based on the modifications to the proxy representation received at the proxy server by using the location information (pars. 0009, 0012, 0033, and 0037-0038; Fig. 2; all users having rights to access the attachments will receive e-mail notifications for any version or content update of a file; IMS will manage and log all check-in, checkout and modification activities related to the attachment, and maintain one updated master copy).

Gong discloses accessing credentials that enable to access the file, but does not explicitly disclose accessing credentials, that enable the proxy server to access the file at the file sources;

However, in an analogous art, DeBry discloses a method for retrieving a file from a file source including step of accessing credentials, that enable the proxy server to access the file at the file sources (*DeBry; abstract; col. 10, lines 45-67 to col. 11, lines 1-15; Fig. 5; wherein at least steps 506-507 and 515-525; user sends digital certificate 506 to publisher/server (digital library 10); the printer server 30 is able to obtain document in Cryptolope, 520, from the digital library 10;*

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of DeBry with the method and system of Gong to include step of accessing credentials, that enable the proxy server to access the file at the file sources to enable a client system to pass authorization, received from a file source, to a printer to retrieve and print a file directly from the file source without the client system ever receiving a copy of the file (*DeBry: abstract; col. 1, lines 29-33*).

- **Regarding claim 2**, Gong and DeBry disclose the method of claim 1.

Gong and DeBry further disclose accessing the credentials comprises accepting the credentials from the file sharer (*Gong: pars. 0009 and 0033; users can access and change the environment setting by login through Client Information Management Web Interface; DeBry: col. 7, lines 43-54; col. 9, lines 5-27; col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5*).

- **Regarding claim 3**, Gong and DeBry disclose the method of claim 1.

Gong and DeBry further disclose accessing the credentials comprises retrieving previously stored credentials (*Gong: pars. 0009 and 0033; DeBry: col. 7, lines 43-54; col. 9, lines 5-27; col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5*).

- **Regarding claim 4**, Gong discloses the method of claim 1.

Gong and DeBry further disclose using the credentials to store a cached copy of the file in association with the proxy representation (*Gong: pars. 0009, 0031, and 0033-*

0036; DeBry: col. 7, lines 43-54; col. 9, lines 5-27; col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5).

- **Regarding claim 5**, Gong discloses the method of claim 1.

Gong and DeBry further disclose storing the credentials in association with the proxy representation (*Gong: par. 0009 and 0034; permission to access the Client Information Management Web Interface will be administrated by the original email creator; IMS will manage and log all check-in, checkout and modification activities related to the attachment; DeBry: col. 7, lines 43-54; col. 9, lines 5-27; col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5*).

- **Regarding claim 6**, Gong and DeBry disclose the method of claim 1.

Gong further discloses accepting a view request from the remote user (*Gong: pars. 0009 and 0035-0036; Fig. 2*); and enabling the remote user to view the file (*Gong: pars. 0009 and 0036; Fig. 2*).

- **Regarding claim 7**, Gong and DeBry disclose the method of claim 1.

Gong further discloses accepting a share request from the remote user (*Gong: pars. 0009, 0020-0021, and 0029; Fig. 2; mail client sends a messages with attachment to a recipient*); and enabling the remote user to share the file with a third party (*Gong: pars. 0009, 0021-0023, 0031-0036; Fig. 2; recipient gets the message and requires downloading the attached file(s)*).

- **Regarding claim 8**, Gong and DeBry disclose the method of claim 1.

Gong further discloses accepting an email request from the remote user (*Gong: pars. 0009 and 0029*); and transmitting an email associated with the file (*Gong: pars. 0009 and 0029*).

- **Regarding claim 9**, Gong and DeBry disclose the method of claim 1.

DeBry further discloses accepting a print request from the remote user (*DeBry: col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5; wherein at least step 515*); and transmitting a print request associated with the file to a remote print service (*DeBry: col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5; wherein at least step 520-525*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of DeBry with the method and system of Gong to include step of accepting a print request from the remote user; and transmitting a print request associated with the file to a remote print service to enable a client system to pass authorization, received from a file source, to a printer to retrieve and print a file directly from the file source without the client system ever receiving a copy of the file (*DeBry: abstract; col. 1, lines 29-33*).

- **Regarding claim 10**, Gong and DeBry disclose the method of claim 1.

DeBry further discloses accepting a fax request from the remote user (*DeBry: col. 10, lines 45-67 to col. 11, lines 1-15; col. 12, lines 14-21; Figs. 1, 4, and 5; wherein at least step 520-525; a fax machine may be understood to be a printer in the context of this invention*); and transmitting a fax request associated with the file to a remote fax service (*DeBry: col. 10, lines 45-67 to col. 11, lines 1-15; col. 12, lines 14-21; Figs. 1, 4, and 5*);

wherein at least step 520-525; a fax machine may be understood to be a printer in the context of this invention).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of DeBry with the method and system of Gong to include step of accepting a fax request from the remote user; and transmitting a fax request associated with the file to a remote fax service to enable a client system to pass authorization, received from a file source, to a printer to retrieve and print a file directly from the file source without the client system ever receiving a copy of the file (*DeBry: abstract; col. 1, lines 29-33*).

- **Regarding claim 11**, Gong and DeBry disclose the method of claim 1.

Gong further discloses the request comprises a request generated by:

viewing a representation of the file within a graphical user interface (*Gong: pars. 0009 and 0029; a dynamic link of all projects (attachment related) to which a user subscribed will be conveniently displayed on email or web-mail client interface*);

selecting the representation of the file within the graphical user interface (*Gong: pars. 0009 and 0029; user sends emails with attachments through email client interface (Outlook, etc.) or web browser based web-mail client interface (Hotmail, etc.)*);

viewing a menu associated with the file, the menu displaying actions that can be performed on the file (*Gong: pars. 0009 and 0029*); and

selecting a share option from the menu (*Gong: pars. 0009 and 0029*).

- **Regarding claim 12**, Gong discloses the method of claim 1.

Gong further discloses generating the proxy representation comprises generating a proxy representation configured to enable the remote user to modify the file (*Gong: pars. 0009, 0033-0034, and 0038*).

- **Regarding claim 13**, Gong discloses the method of claim 1.

Gong further discloses generating the proxy representation comprises generating a proxy representation configured to enable the remote user to read the file (*Gong: pars. 0009, 0033-0034, and 0038*).

- **Regarding claim 14**, Gong and DeBry disclose the method of claim 1.

Gong and DeBry further disclose storing credentials comprises accepting the credentials from the file sharer (*Gong: pars. 0009 and 0033; DeBry: col. 7, lines 43-54; col. 9, lines 5-27; col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5*).

- **Regarding claim 15**, Gong and DeBry disclose the method of claim 1.

Gong further discloses determining if a database entry associated with the remote user is stored on an account database (*Gong: pars. 0009, 0030, and 0033*).

- **Regarding claim 16**, Gong and DeBry disclose the method of claim 15.

Gong further discloses storing the proxy representation in association with the database entry associated with the remote user in response to a positive determination (*Gong: pars. 0009 and 0029-0036; after successfully logging into user's email account, the user is able to either send email with attachments or downloading the attached file*).

- **Regarding claim 19**, Gong and DeBry disclose the method of claim 1.

Gong further discloses accepting a retrieval request from the remote user (*Gong: pars. 0009 and 0035-0038*).

- **Regarding claim 20**, Gong discloses the method of claim 19.

Gong and DeBry further disclose using the credentials to retrieve the file (*Gong: pars. 0009 and 0033-0037; DeBry: col. 7, lines 43-54; col. 9, lines 5-27; col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5*).

- **Regarding claim 21**, Gong discloses the method of claim 19.

Gong and DeBry further discloses the retrieval request includes authentication information for the remote user (*Gong: pars. 0009 and 0033-0037; DeBry: col. 7, lines 43-54; col. 9, lines 5-27; col. 10, lines 45-67 to col. 11, lines 1-15; Figs. 1, 4, and 5*).

- **Regarding claim 22**, Gong discloses the method of claim 19.

Gong further discloses providing access to a cached version of the file (*Gong: pars. 0009 and 0036-0038*).

- **Regarding claim 23**, Gong discloses the method of claim 19.

Gong further discloses accepting a modification request from the remote user (*Gong: pars. 0009 and 0036-0038*).

- **Regarding claim 24**, Gong discloses the method of claim 23.

Gong further discloses the modification request includes authentication information (*Gong: pars. 0009 and 0036-0038*).

- **Regarding claim 25**, Gong discloses the method of claim 23.

Gong further discloses using the credentials to modify the file (*Gong: pars. 0009 and 0036-0038*).

- **Regarding claim 26**, Gong discloses the method of claim 23.

Gong further discloses modifying a cached version of the file in response to the modification request (*Gong: pars. 0009 and 0036-0038*); and notifying the file sharer that the cached version has been modified (*Gong: pars. 0009 and 0038; all users having rights to access the attachments will receive email notifications for any version or content update of a file*).

- **Regarding claim 27**, Gong discloses the method of claim 26.

Gong further discloses synchronizing the file with the cached version in response to a request from the file sharer (*Gong: pars. 0009 and 0036-0038*).

- **Regarding claim 28**, Gong discloses the method of claim 25.

Gong further discloses notifying the file sharer that the file has been modified (*Gong: pars. 0009 and 0038; all users having rights to access the attachments will receive email notifications for any version or content update of a file*).

- **Regarding claim 29**, Gong discloses a system for sharing files with remote users (*par. 0009; Fig. 2*), the system comprising:

a proxy server that includes a proxy database storing proxy representations, the proxy database being embodied in a computer readable storage medium, wherein the proxy

representations configured to enable access to files for remote users (*pars. 0009 and 0029-0031; Fig. 2*); and

a proxy stored on the computer readable storage medium and configured to:

accept, at the proxy server, a request from a file sharer to share a file with a remote user (*pars. 0009, 0020, and 0029; Fig. 2; user sends emails with attachments through email client interface*);

access credentials, that enable [[the proxy server]] to access the file at the file resource (*pars. 0009, 0030, and 0033; users can access the Client Project Information Management Web Interface to manage attachment information; login authentication is needed*); and

generate a proxy representation for the file on the proxy server (*pars. 0009, 0031, and 0034; a unique attachment descriptor and locator will be generated to identify the save attachment; a version controlled copy of the original attachment from the IMS*).;

receive one or more modification to the proxy (*pars. 0009, 0012, 0033, and 0037-0038; Fig. 2; the recipient can modify the file(s) in his/her local machine and check in the modified version through email or through Client Information Management Web Interface*); and

update the file located at the file source based on the modifications to the proxy received at the proxy server (*pars. 0009, 0012, 0033, and 0037-0038; Fig. 2; all users having rights to access the attachments will receive e-mail notifications for any*

version or content update of a file; IMS will manage and log all check-in, checkout and modification activities related to the attachment, and maintain one updated master copy).

Gong discloses accessing credentials that enable to access the file, but does not explicitly disclose accessing credentials, that enable the proxy server to access the file at the file sources;

However, in an analogous art, DeBry discloses a method for retrieving a file from a file source including step of accessing credentials, that enable the proxy server to access the file at the file sources (*DeBry; abstract; col. 10, lines 45-67 to col. 11, lines 1-15; Fig. 5; wherein at least steps 506-507 and 515-525; user sends digital certificate 506 to publisher/server (digital library 10); the printer server 30 is able to obtain document in Cryptolope, 520, from the digital library 10*);

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of DeBry with the method and system of Gong to include step of accessing credentials, that enable the proxy server to access the file at the file sources to enable a client system to pass authorization, received from a file source, to a printer to retrieve and print a file directly from the file source without the client system ever receiving a copy of the file (*DeBry; abstract; col. 1, lines 29-33*).

- **Regarding claims 30-44**, claims 30-44 are similar in scope to claims 2-16, and are therefore rejected under similar rationale.

- **Regarding claims 47-56**, claims 47-56 are similar in scope to claims 19-28, and are therefore rejected under similar rationale.

- **Regarding claim 57**, claim 57 is similar in scope to claims 1, and is therefore rejected under similar rationale.

- **Regarding claims 58-72**, claims 58-72 are similar in scope to claims 2-16, respectively, and are therefore rejected under similar rationale.

- **Regarding claims 75-84**, claims 75-84 are similar in scope to claims 19-28, respectively, and are therefore rejected under similar rationale.

10. **Claims 17-18, 45-46, and 73-74 are rejected under 35 U.S.C. 103(a)** as being unpatentable over Gong and DeBry, as applied to claims 1, 29, and 57 above, in view of Jhingan et al., (hereinafter “Jhingan”), U.S. Patent Publication No. 2004/0186851, filed on March 21, 2003.

- **Regarding claim 17**, Gong and DeBry disclose the method of claim 15.

Gong does not explicitly disclose generating a new database entry associated with the proxy representation for the remote user in response to a negative determination.

However, in an analogous art, Jhingan discloses a method for email attachment distribution, wherein generating a new database entry associated with the proxy representation for the remote user in response to a negative determination (*Jhingan: par.*

0057; in situation where the recipient system 102 does not exists, then a new user profile is created for which the user can submit a password and preferred location for future deliveries).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Jhingan with the method and system of Gong and DeBry, to include generating a new database entry associated with the proxy representation for the remote user in response to a negative determination to provide user with a means for enabling collaboration through large email attachment (*Jhingan: par. 0008*).

- **Regarding claim 18**, Gong, DeBry, and Jhingan disclose the method of claim 17.

Jhingan further discloses transmitting an email containing a registration key to the remote user (*Jhingan: par. 0034; the locator object may be embedded as a linked object with the email and sent to a recipient system 102; the attachment associated with the locator code may be downloaded from a server to the recipient system 102*).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Jhingan with the method and system of Gong and DeBry, to include transmitting an email containing a registration key to the remote user to provide user with a means for enabling collaboration through large email attachment (*Jhingan: par. 0008*).

- **Regarding claims 45-46**, claims 45-46 are similar in scope to claims 17-18, respectively, and are therefore rejected under similar rationale.
- **Regarding claims 73-74**, claims 73-74 are similar in scope to claims 17-18, respectively, and are therefore rejected under similar rationale.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luu Pham whose telephone number is 571-270-5002. The examiner can normally be reached on Monday through Friday, 7:30 AM - 5:00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Luu Pham/
Examiner, Art Unit 2437

/Emmanuel L. Moise/
Supervisory Patent Examiner, Art Unit 2437